



16
Docket No. 1080/0011US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE RECEIVED

In re Patent No. 5,912,126 (Formerly U.S. Appl. Ser. No.: 08/727,509)
Filed: 10/22/1996
Issued: 6/15/1999

OCT 21 2010
OFFICE OF PETITIONS

For: **Methods for Labeling DNA Ends with Halogenated Nucleotides and Detecting
Same with Antibodies**

PETITION UNDER 37 C.F.R. § 1.378 (b):
PETITION TO ACCEPT UNAVOIDABLY DELAYED
PAYMENT OF MAINTENANCE FEES

Mail Stop: PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

2010 OCT 18 PM 3:59

Sir:

Applicants hereby petition the Commissioner under 37 CFR § 1.378 (b) requesting that the Commissioner find that payment of the subject maintenance fees was unavoidably delayed, accept payment of the fees due and reinstate the above-captioned patent.

The Petition has been submitted with the fees believed due. The Commissioner is authorized to charge any shortage of fees paid or credit any overages to **Deposit Account No. 50-2549.**

INTRODUCTION

The above-reference patent expired for delayed payment of the second maintenance fees.

The instant petition is filed to show that the delay in payment of the second maintenance fees was unavoidable.

Petitioner submits that it exercised reasonable, due care to ensure timely payment of the subject maintenance fees. Specifically, Petitioner submits that the system to ensure payment of the subject maintenance fees A) was reasonably calculated to ensure the timely payment of maintenance fees, B) relied upon reliable and trustworthy employees, agents and instrumentalities, C) had proven itself reliable and functional and D) failed only through the unforeseen fault or imperfection of its agencies or instrumentalities.

Additionally, Petitioner submits that the present petition was filed promptly after the patentee was notified of the expiration of the patent. Specifically, Petitioner submits 1) that it believed the physical, law firm prosecution file (hereinafter, "prosecution file") would be helpful or necessary to reinstate the subject patent, 2) immediately began efforts to locate the prosecution file upon notification of the expiration of the patent, 3) was prevented from locating the prosecution file by the dissolution and split of the law firm that most likely possessed the prosecution file and 4) subsequent to unsuccessfully obtaining the prosecution file, promptly retained counsel to file the subject petition.

Therefore, applicants respectfully request that the Commissioner: find that payment of the subject maintenance fees was unavoidably delayed, accept payment of the fees due and reinstate the subject patent.

DISCUSSION

I. Petitioner Exercised Reasonable, Due Care to Ensure Timely Payment of the Subject Maintenance Fees.

“The Director may accept the payment of any maintenance fee required by subsection (b) of this section at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.” 35 U.S.C. § 41 (c)(1). The standard of unavoidable under 35 U.S.C. § 41 (c)(1) is identical to the standard that has been established for reviving an abandoned application under 35 U.S.C. § 133. MPEP § 2590 (I) (citing Ray v. Lehman, 55 F.3d 606, 608-609 (Fed. Cir. 1995)). In general terms, the standard established is that of the due care of a prudent and careful person in relation to their most important business. In re Mattullath, 38 App. D.C. 497, 514-515 (1912). Decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Ray v. Lehman, 55 F.3d 606, 608-609 (Fed. Cir. 1995). A petitioner's actions may be gauged while taking into account their financial position, station in life and other obligations. See Smith v. Goodyear Dental Vulcanite Co., 93 U.S. 486 (1877); Mattullath, at 515; In re Patent No. 6,340,388, 2009 Commr. Pat. 6. The petitioner has the burden of establishing that the delay was unavoidable. Rydeen v. Quigg, 748 F. Supp. 900, *aff'd* 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992). An adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. 41(c) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. MPEP § 2590 (I) (citing Ray v. Lehman, at 609).

A. Petitioner's Financial Position, Station in Life and Other Obligations

Petitioner is a small, not-for-profit, medical college, with limited resources, and is constantly engaged in the difficult balance of protecting its intellectual property, pursuing novel, life-saving research, educating future medical providers and retaining talented staff

and faculty all while attempting to maintain sufficient funding for the above necessities (See e.g. Declaration by Catharine Crea, par. 5 and 14. Historically, as well as currently, Petitioner has been engaged in research and development of technology relevant to various, pandemic diseases such as developing a vaccine for the H1N1 ("swine flu") influenza virus, developing treatments for cardiovascular diseases, kidney disease, Alzheimer's Disease, Parkinson's Disease, multiple sclerosis, Lou Gehrig's Disease as well as DNA-level cancer treatments (See Declaration by Catharine Crea, par. 4). Petitioner submits that its obligation to maintain its pursuit of its research activities comes from both a moral obligation to the patient and health community as well as its obligation to its own mission statement and vision.

Prior to the time that the subject maintenance fees became due, Petitioner was experiencing difficult financial constraints (See Declaration by Catharine Crea, par. 14). Petitioner submits that in and around 2004-2005, New York Medical College was facing a shrinking budget along with financial burdens leading to a budget deficit of approximately \$7,000,000. These financial constraints forced Petitioner to make staffing cutbacks (*Id.*). The individual whose responsibilities included managing intellectual property matters for Petitioner, Dr. Stella Manne, was laid off and her responsibilities were reassigned to her superior, Associate Dean Catharine Crea (See Declaration by Catharine Crea, par. 14-16). Petitioner submits that such staffing cuts were reasonable, if not morally necessary, in light of the importance of preserving the funding being used to continue the valuable, life-saving medical research that Petitioner was and still is pursuing. Additionally, Dean Crea had a large amount of experience receiving and approving requests for payment of many different matters, including patent maintenance fees, for New York Medical College at the time the subject fees were payable (See Declaration by Catharine Crea, par. 17-19). Therefore, Petitioner submits that it was reasonable for Petitioner, acting regarding its most important business while facing great financial challenges affecting other matters important to its existence, to eliminate Dr. Manne's position and entrust Dean Crea with the management of the subject patent. This change did not affect Petitioner's ability and intent to pay maintenance fees in the present patent as discussed in more details below.

Additionally, the present situation is different from the one in which Petitioner was “sitting on its rights,” or disinterested in the subject patent until the market took notice. *See e.g. Patentee: Bosque et al.*, 2006 Commr. Pat. LEXIS 88. Petitioner submits that the facts indicate the opposite. Petitioner was motivated to maintain the subject patent, because the patent was an ongoing business concern (*See Declaration by Catharine Crea*, par. 3 and 9). The subject patent was—and still is—subject to a license agreement and the revenue that the license agreement generates is very important to New York Medical College and contributes to funding the research that Petitioner performs (*Id.*). To a budget-conscious organization, such as New York Medical College, a revenue-generating patent is treated as an important asset, the rights to which are carefully protected within its limited means (*See Declaration by Catharine Crea*, par.6).

B. Petitioner’s System for Payment of Maintenance Fees was Reasonably Calculated to Ensure Timely Payment

Failure to receive Maintenance Fee Reminders that are routinely sent from the Patent and Trademark Office may not necessarily establish a claim of unavoidable delay and does not shift the burden of notice to the Office for notification that fees are due or patent rights may be lost. *See e.g. MMTC, Inc. v. Rogan*, 369 F. Supp. 2d 675 (E.D. VA, 2004). Accordingly, Petitioner did not rely on maintenance fee reminder notices from the Patent and Trademark Office. Petitioner relied upon Computer Patent Annuities Global, Ltd. (hereinafter, “CPA”) as well as the law firm of Graham & James, L.L.P. as a “back-up” and their respective docketing systems to ensure timely payment of maintenance fees (*See Declaration by Catharine Crea*, par. 5 and 7).

Petitioner had the following business routine in place for the handling of patent maintenance fees:

- Petitioner requests that CPA, in exchange for a fee, docket the maintenance fee due dates of a patent.
- When maintenance fees become payable, CPA notifies Petitioner by letter via the United States Postal Service.

- Mail is received at the New York Medical College Administrative Building by Ms. Allison Goveia.
- Ms. Goveia sorts the mail according to addressee within the Administrative Building and physically delivers the separated mail to its intended recipient. Specifically, mail intended for Dean Crea, such as mail from CPA regarding the subject maintenance fees, was delivered by Ms. Goveia to Ms. Susan Dudek.
- Ms. Susan Dudek then delivers the mail to Dean Crea.
- Petitioner would then internally approve payment of maintenance fees.
- Petitioner would notify CPA that it is authorized to pay the maintenance fees.
- CPA would issue payment of the maintenance fees to the U.S. Patent and Trademark Office.
- CPA would then send Petitioner an invoice for any fees paid.
- Petitioner would issue a check to CPA for the invoiced amount and send the check to CPA via United States Postal Service or other reliable carrier (e.g. UPS, FedEx or DHL).

(See Declaration by Catharine Crea, par. 10)

However, Petitioner submits that Dean Crea did not receive any notice from CPA or Graham & James regarding the subject maintenance fees (See Declaration by Catharine Crea, par. 32 and 33). The chain of handling mail intended for Dean Crea in the New York Medical College Administrative Building follows a simple path from Ms. Goveia, to Ms. Dudek to Dean Crea (See Declaration by Catharine Crea, par. 25-27). Neither Ms. Goveia, nor Ms. Dudek filtered, screened or otherwise impeded any pieces of mail in reaching Dean Crea (See Declaration by Catharine Crea, par. 24, Declaration by Allison Goveia, par. 4 and Declaration by Susan Dudek, par. 4). Petitioner respectfully submits that the mail delivery system within New York Medical College's Administrative Building was designed to be, and was, both simple and reliable.

Thus, Petitioner submits that it was reasonable to expect that important notices, such as one from CPA and/or Graham & James regarding the subject maintenance fees, would be received by Dean Crea. Petitioner, and specifically Dean Crea, has attempted to find out where its simple, reliable system failed, but it has been unable to identify the specific, responsible individual, agent or component (*See Declaration by Catharine Crea*, par. 34).

C. Petitioner Relied upon Reliable and Trustworthy Employees, Agents and Instrumentalities

Despite Petitioner's financial constraints discussed above, Petitioner engaged, and still engages, world-class, reputable, trustworthy and reliable law firms and docketing agents in the management of its intellectual property—including docketing maintenance fees for the subject patent—because the intellectual property is very important to Petitioner (*See Declaration by Catharine Crea*, par. 6). Petitioner submits that CPA (as well as Graham & James, during its existence) is a well-known and globally-recognized firm which specializes in, *inter alia*, maintenance fee docketing (*See* <http://www.cpaglobal.com/patents/renewals>).

It is also reasonable for one to rely on the mail in the course of designing and relying on a system to ensure payment of maintenance fees. *In re Mattullath*, 38 App. D.C. 497, 514-515 (1912). CPA states that it sent notice, via mail, regarding the maintenance fees for the subject patent (*See Declaration by Catharine Crea*, par. 31). Previously, Petitioner had received and responded appropriately to maintenance fee notice sent by CPA regarding the subject patent (*See Declaration by Catharine Crea*, par. 11-13). Petitioner respectfully submits that it reasonably relied on the mail, as it had done so previously and successfully, to ensure the payment of the subject maintenance fees.

Additionally, it is reasonable for one to rely on trustworthy and reliable employees in the course of designing and relying on a system to ensure payment of maintenance fees. *Mattullath*, 514-515. Both Allison Goveia and Susan Dudek are long-term, reliable and trustworthy employees of New York Medical College (*See Declaration*

by Catharine Crea, par. 26). They both enjoy now, and enjoyed at the time the subject fees were payable, a reputation as reliable and trustworthy employees who competently and faithfully discharged their duties as administrative assistants (*Id.*).

Moreover, at the time the subject fees were payable, Petitioner, through Dean Crea, managed 26 patents (*See Declaration by Catharine Crea, par. 19*). Dean Crea's management of Petitioner's patents includes receipt of notices that maintenance fees are due from annuity agencies or attorneys, obtaining approval for or approving funding from New York Medical College for payment of maintenance fees, authorizing agents to make maintenance fee payments and ensuring that maintenance fee payments are forwarded to such agents (*See Declaration by Catharine Crea, par. 18*). However, the payment of maintenance and other fees relies upon Petitioner receiving notices from its agents and attorneys. Unfortunately, Dean Crea did not receive notice to pay the subject maintenance fees (*See Declaration by Catharine Crea, par. 32-33*).

D. Petitioners System for Payment of Maintenance Fees had Proven Itself Reliable and Functional

CPA's and Petitioner's system for payment of maintenance fees had shown itself to be reliable and functional (*See Declaration by Catharine Crea, par. 11-13 and 20-21*). Petitioner had established a relationship with CPA beginning in 2001, approximately 5 years prior to the time the subject maintenance fees were payable (*See Declaration by Catharine Crea, par. 8*). CPA has acted as an agent for docketing and payment of fees for 5 of Petitioner's patents and the system in place between Petitioner and CPA has repeatedly shown itself to be reliable and functional—even as to the subject patent (*See Declaration by Catharine Crea, par. 8, 11-13 and 20-21*). As an indicator of the reliability and functionality of the notification system between Petitioner and CPA, Petitioner received notice from CPA that the 3.5 year maintenance fees for the subject patent were due. Petitioner subsequently authorized CPA to pay the maintenance fees on its behalf. The 3.5 year maintenance fees due for the subject patent were paid by CPA on behalf of and at the request of Petitioner. (*See Declaration by Catharine Crea, par. 11-13 and 20-21 and Attachment thereto.*)

Moreover, out of the 26 patents previously mentioned that Dean Crea was managing for Petitioner, the subject patent is the only patent managed by Petitioner—let alone managed by Petitioner and CPA together—which is before the Commissioner on a Petition to Accept Unavoidably Delayed Maintenance Fees (*See* Declaration by Catharine Crea, par. 21). Thus, Petitioner submits that the business routine established between itself and CPA had repeatedly shown itself to be functional and reliable.

E. Petitioner's System Failed Only Through the Unforeseen Fault or Imperfection of its Agencies or Instrumentalities

“If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable.” Mattullath, 514-515. As discussed above: 1) Petitioner had an ongoing interest and motivation to maintain the subject patent. 2) Petitioner took and continues to take measures to carefully protect its intellectual property rights despite having limited resources by employing well-known attorneys and agents. 3) The agent responsible for notifying Petitioner for payment of the subject maintenance fees, CPA, states that it sent notice to Petitioner via the mail. 4) There was a reliable and functional business routine in place for the handling of the mails. 5) The staff at New York Medical College responsible for handling the mail intended for Dean Crea could be reasonably relied upon to perform their tasks. 6) Dean Crea understood her responsibility to maintain and protect Petitioner's intellectual property rights, especially those pertaining to a revenue-generating patent such as the subject patent. 7) There was a business routine in place to issue payment of patent maintenance fees which has been historically reliable. 8) New York Medical College has historically, reliably and responsibly managed their intellectual property rights, and continues to do so. Petitioners submit that, through unforeseen fault or imperfection, the tested and successful system for notification and payment of patent maintenance fees, which was reasonably calculated to function properly and had previously functioned properly, did not function properly in this instance, thus, the instant patent maintenance fees were unavoidably delayed.

II. The Instant Petition was Filed Promptly After the Patentee was Notified of the Expiration of the Patent.

Dean Crea, on behalf of Petitioner, began investigating the circumstances surrounding the failure to submit the subject maintenance fees immediately after being notified that the subject patent had expired (*See Declaration by Catharine Crea, par. 36*). Dean Crea believed that the physical, law firm prosecution file would at least be helpful, if not necessary, for resolving the circumstances surrounding the non-payment of the subject maintenance fees (*Id.*). Petitioner submits that given its above-discussed financial constraints, it was reasonable for Dean Crea to attempt to investigate the matter on her own as much as possible, to avoid unnecessary or very large bills from law firms attempting to obtain information otherwise available to her.

The law firm Skadden, Arps, Slate, Meagher & Flom, L.L.P. (hereinafter, "Skadden, Arps") and, subsequently, Graham & James, L.L.P. prosecuted the subject patent to allowance (*See Declaration by Catharine Crea, par. 6 and 7*). Accordingly, Dean Crea contacted Skadden, Arps who informed her that the entire physical prosecution file had been transferred to Mr. Stefan Kirchanski of Graham & James, L.L.P. (*See Declaration by Catharine Crea, par. 39.*) Unfortunately, shortly after the issue of the subject patent, Mr. Kirchanski left Graham & James and the law firm of Graham & James dissolved and split in July, 2000 leaving Dean Crea unable to get into contact with Graham & James or locate Mr. Kirchanski. Thus, Dean Crea requested the assistance of New York Medical College's General Counsel in locating contact information for either Mr. Kirchanski or Graham & James (*See Declaration by Catharine Crea, par. 40*).

Dean Crea also contacted Skadden, Arps, again, in an effort to obtain additional information, but was unsuccessful in obtaining any additional, useful information (*See Declaration by Catharine Crea, par. 42*). She then contacted the licensee of the subject patent, Phoenix Flow Systems, in an attempt to obtain contact information for Mr. Kirchanski (*See Declaration by Catharine Crea, par. 43*) Phoenix Flow Systems was finally able to provide Mr. Kirchanski's contact information, who was now at Venable, L.L.P. (*See Declaration by Catharine Crea, par. 43 and 45*). However, Mr. Kirchanski and Dean Crea, together, were unable to locate the physical prosecution file for the

subject patent (*See* Declaration by Catharine Crea, par. 46). Dean Crea abandoned her attempts to investigate the matter and locate the physical prosecution file on her own and requested that NADA JAIN, P.C. investigate the matter and file the present petition to reinstate the subject patent (*See* Declaration by Catharine Crea, par. 46).

NADA JAIN, P.C. has proceeded to investigate material facts surrounding non-payment of the subject patent, obtain additional documents, research the relevant statutes, case law and requirements relevant to reinstatement of the subject patent, prepare relevant declarations and the present Brief and now files the present petition before the Commissioner.

In view of the above, Petitioner respectfully submits that it has been diligent in its pursuit of collecting relevant evidence and filing the instant petition.

III. Reinstatement of the Subject Patent is also Equitably Appropriate

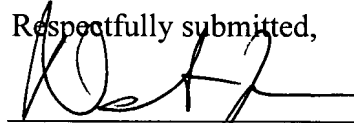
Finally, Petitioners submit that reinstatement of the subject patent is in keeping with the spirit of equity of the U.S. patent system. *See e.g. Mattullath*, at 515. A petitioner's actions may be gauged while taking into account their financial position, station in life and other obligations. *See Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486 (1877); *Mattullath*, at 515; *In re Patent No. 6,340,388*, 2009 Commr. Pat. 6. The decision to reinstate a patent based on unavoidable delay is to be decided on a case-by-case basis, taking all facts and circumstances into account. *Ray v. Lehman*, 609-608. Petitioner submit that this Petition should be granted in view of (i) Petitioner's successful management of its other intellectual property rights; (ii) its clear understanding of the importance of intellectual property shown by its choice to utilize reputable and reliable agents and attorneys for docketing and prosecution despite having limited means; (iii) its simple, and historically reliable business routine that was in place to ensure payment of the subject maintenance fees; and (iv) since denying reinstatement of the subject patent would work a great hardship on a small, medical college whose not-for-profit existence is at least partially dependent on the revenue received from the licensing of the subject patent as well as other patents.

CONCLUSION

Petitioner respectfully requests that the Commissioner find that the subject maintenance fees were unavoidably delayed, accept the late payment of the maintenance fees and reinstate the subject patent.

Date: October 11, 2010

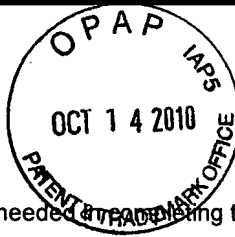
Respectfully submitted,



Nada Jain
Reg. No. 41,431

SEND CORRESPONDENCE TO:

NADA JAIN, P.C.
560 White Plains Road, Suite 460
Tarrytown, NY 10591
T: (914) 333-0610 x 150
F: (914) 333-0615

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))**Docket Number (Optional)
1080/0011US1Mail to: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450
Fax: (571) 273-830010/19/2010 DALLEN 00000011 502549 5912126
01 FC:1599 1940.00 DA

NOTE: If information or assistance is needed in preparing this form, please contact Petitions Information at (571) 272-3282.

RECEIVED**OCT 21 2010**Patent Number: 5,912,126Application Number: 08/727,509Issue Date: June 15, 1999Filing Date: October 22, 1996**OFFICE OF PETITIONS**

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

☐ is a reissue of original Patent No. _____ original issue date _____
 original application number _____
 original filing date _____

☒ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application
PCT/US96/14250 filed on August 28, 1996
CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

October 12, 2010

Date

Signature

Nada Jain

Typed or printed name of person signing Certificate

1. SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$ _____	3 ½ yr fee	(1551)	<input type="checkbox"/> \$ _____	3 ½ yr fee	(2551)
<input checked="" type="checkbox"/> \$ 2610	7 ½ yr fee	(1552)	<input type="checkbox"/> \$ _____	7 ½ yr fee	(2552)
<input type="checkbox"/> \$ _____	11 ½ yr fee	(1553)	<input type="checkbox"/> \$ _____	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ 2610

4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ 700

5. MANNER OF PAYMENT

- ☐ Enclosed is a check for the sum of \$ _____
- ☒ Please charge Deposit Account No. 502549 the sum of \$ _____
- ☐ Payment by credit card. Form PTO-2038 is attached.

6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

- ☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 502549

7. OVERPAYMENT

As to any overpayment made, please

☒ Credit to Deposit Account No. 502549

OR

☐ Send refund check

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.



Signature(s) of Petitioner(s)

October 11, 2010

Date

Nada Jain

Typed or printed name(s)

41,431

Registration Number, if applicable

NADA JAIN, P.C.

Address

914 333-0610

Telephone Number

560 White Plains Road, Tarrytown, NY 10591

Address

ENCLOSURES:

- ☒ Maintenance Fee Payment
☒ Statement why maintenance fee was not paid timely
☒ Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)

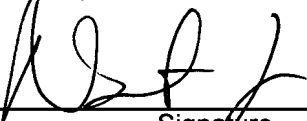


Other:

Declaration by C Crea w/attachments; Declaration by S Dudek, Declaration by A Goveia

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."



SignatureOctober 11, 2010

Date

Nada Jain

Type or printed name

41,431

Registration Number, if applicable

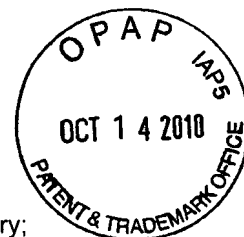
STATEMENT

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

Please see attached Petition and Statement and Declarations by C Crea, S Dudick, and A Goveia.

(Please attach additional sheets if additional space is needed)

Privacy Act Statement



The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



Docket No. 1080/0011US1

THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

In re Patent No. 5,912,126 (Formerly U.S. Appl. Ser. No.: 08/727,509)

Filed: 10/22/1996

Issued: 6/15/1999

OCT 21 2010

OFFICE OF PETITIONS

For: **Methods for Labeling DNA Ends with Halogenated Nucleotides and Detecting Same with Antibodies**

DECLARATION BY SUSAN DUDICK

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

2010 OCT 18 PM 3:18
USPTO
RECEIVED
OCT 15 2010
OFFICE OF PETITIONS

1. My name is Susan Dudick. I am Dean Catharine Crea's administrative assistant at New York Medical College, Valhalla, New York, 10595 and am responsible for, among other things, receiving mail for Associate Dean Catharine Crea. I write this declaration in support of the petition to accept an unavoidably delayed payment of a maintenance fee for the above-captioned patent.
2. I am an employee of New York Medical College and receive no special benefits from the execution of this declaration.
3. At the time the subject maintenance fees were payable, in the period of 2006/2007, I was employed as Associate Dean Catharine Crea's administrative assistant and my duties included receiving all mail for Dean Crea and responding to certain pieces after Dean Crea's review and direction.
4. Daily, I received mail for Dean Crea and we reviewed the mail together. I did not make decisions regarding which mail Dean Crea was to review and I did not discard mail without Dean Crea's review and direction to do so.
5. I was employed at New York Medical College as Dean Crea's administrative assistant at the time that Dr. Stella Manne's position was eliminated in 2005 and I knew that all mail addressed to Dr. Manne was to be redirected to Dean Crea for

her review. Therefore, at the time the subject maintenance fees were payable, I was accustomed to receiving mail addressed to Dr. Stella Manne and I knew that it was to be reviewed by Dean Crea.

6. At the time the subject maintenance fees were payable, I do not recall receiving mail from Computer Patent Annuities addressed to Dr. Manne with respect to this case. However, if it were received, I would have given it to Dean Crea for her review per our standard procedure.
7. To date, I still occasionally receive mail addressed to Dr. Manne that is redirected to Dean Crea and I continue to ensure that it is delivered to Dean Crea for her review.
8. I declare that the above statements are true to the best of my knowledge.

Date: 8/16/10

Signed: Susan Dudick
Susan Dudick



Docket No. 1080/0011US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

In re Patent No. 5,912,126 (Formerly U.S. Appl. Ser. No.: 08/727,509)

OCT 21 2010

Filed: 10/22/1996 }

Issued: 6/15/1999

OFFICE OF PETITIONS

For: **Methods for Labeling DNA Ends with Halogenated Nucleotides and Detecting Same with Antibodies**

DECLARATION BY CATHARINE CREA

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

2010 OCT 18 PM 3:59

1. My name is Catharine Crea. I am the Associate Dean for Research Administration at New York Medical College, Office of Research Administration Administration Building, Valhalla, New York, 10595 and am responsible for management of the intellectual property rights associated with the above-referenced patent. I write this declaration in support of the petition to accept an unavoidably delayed payment of a maintenance fee for the above-captioned patent.
2. I am an employee of New York Medical College and receive no special benefits from the execution of this declaration.
3. The invention relating to the subject patent and application has been, since November 2, 1995, and continues to be, subject to a license agreement between New York Medical College and Phoenix Flow Systems. New York Medical College continues to receive payment of royalties under this license agreement, which is an important source of income for New York Medical College.
4. New York Medical College is presently—and has been, historically—engaged in the research of technology related to the development of vaccines for many pandemic diseases, including the H1N1 (“swine flu”) virus as well as treatment of

other diseases such as cardiovascular diseases, kidney disease, Alzheimer's Disease, Parkinson's Disease, multiple sclerosis as well as DNA-level cancer treatments.

5. Due to its small size and limited resources, New York Medical College does not maintain an internal docketing system and relies on its attorneys and agents to maintain an appropriate docketing system for payment of maintenance fees.
6. However, on balance with the importance that intellectual property assets represent to New York Medical College, experienced and well-recognized agents such as Skadden, Arps, Slate, Meagher & Flom, L.L.P. (hereinafter Skadden, Arps), Amster, Rothstein & Ebenstein, L.L.P. (hereinafter Amster, Rothstein), Graham & James, L.L.P. and Computer Patent Annuities, Ltd. (hereinafter, CPA) are employed to pursue and protect New York Medical College's intellectual property rights.
7. New York Medical College retained Computer Patent Annuities with the duty of docketing maintenance fees for the subject patent. We additionally relied on the docketing system at the law firm of Graham & James—which prosecuted this case to allowance—as a back-up.
8. Since 2001, New York Medical College and CPA have worked together in docketing and managing payment of New York Medical College's patent maintenance fees.
9. At all times, since the application for the subject patent was filed, New York Medical College intended to pursue and maintain the subject patent and comply with maintenance fee requirements.
10. The business routine between New York Medical College and CPA for docketing and ensuring payment of maintenance fees is described below. Such system has not substantially changed since New York Medical College and CPA began working together, because it had proven to be greatly successful and reliable.
 - a. New York Medical College requests that CPA, in exchange for a fee, docket the maintenance fee due dates of the subject patent.
 - b. When maintenance fees become payable, CPA notifies New York Medical College by letter via the United States Postal Service.

- c. At the time the subject maintenance fees were payable, all mail pertaining to the subject patent, and any other patent, was to be directed to me for review and action.
 - d. New York Medical College internally approves payment of maintenance fees.
 - e. New York Medical College notifies CPA that it is authorized to pay maintenance fees.
 - f. CPA issues payment of the maintenance fees to the Patent and Trademark Office.
 - g. CPA sends New York Medical College an invoice for any fees paid and New York Medical College issues a check for the services rendered and fees paid and sends the check via United States Postal Service or other reliable carrier (e.g. UPS, FedEx or DHL) to CPA.
11. The above system had proven itself to be reliable as to the subject patent, specifically, because New York Medical College received notice from CPA that its first maintenance fees were due. (*See*, Attachment 1)
12. After receiving notification from CPA that the first maintenance fees were due for the subject patent, New York Medical College responded with instructions to CPA—on CPA’s provided form—to pay the subject patent’s first maintenance fees. (*See*, Attachment 1, “Yes” response and signature of Dr. Stella Manne authorizing payment of maintenance fees)
13. On or about August 29, 2002, CPA, on behalf of New York Medical College, paid the subject patent’s first maintenance fees; thus, the system in place to ensure payment of the subject maintenance fees appears to have been functioning properly.
14. New York Medical College is a small entity with limited resources. Unfortunately, on October 27, 2005, due to a budget gap of over \$7,000,000, New York Medical College had to eliminate the position of Dr. Stella Manne, Director of the Technology Department, along with 14 other filled positions and 34 unfilled positions.

15. Dr. Manne's responsibilities included receiving and responding to mail regarding the subject patent.
16. Dr. Manne's responsibilities were consolidated into my position, Associate Dean for Research Administration. Therefore, my responsibilities from October, 2005 onward were consolidated to include management of intellectual property matters, including managing the payment of maintenance fees for the subject patent.
17. Because I was Dr. Manne's supervisor, I was already experienced and familiar with the management of New York Medical College's intellectual property matters and comfortable with assuming Dr. Manne's responsibilities.
18. At the time the subject maintenance fees were payable, I was very experienced in receiving and responding to many funding requests, including those for legal matters such as patent maintenance fees, and receiving and responding to such requests was routine in my position. (See Attachments 2 and 3, Check Request No. 274434 and Check Request No. 313643, respectively, approved by me)
19. At the time the subject maintenance fees were payable, *i.e.*, from 2006-2007, I was managing 26 patents and patent applications on behalf of New York Medical College.
20. Specifically, CPA and New York Medical College have worked together to manage the docketing of a total of 5 patents for New York Medical College.
21. The subject patent is the only patent that I have managed that is before the Commissioner for acceptance of unavoidably delayed payment of maintenance fees.
22. After the elimination of Dr. Manne's position, all mail addressed to Dr. Manne was to be directed to me for review and appropriate response.
23. All mail-handling staff members in the Administrative Building of New York Medical College knew Dr. Manne's position was eliminated, both because they were directly informed and because they were employees in the New York Medical College Administrative Building at the time Dr. Manne was laid off.
24. All mail-handling staff were instructed to forward any and all correspondence addressed to Dr. Manne to me. Mail-handling staff were not requested, directed

- or authorized to engage in deciding which mail to forward to me, return to sender or discard.
25. At the time the subject maintenance fees were payable, Alison Goveia and Susan Dudick were responsible for receiving and distributing mail and packages received in the Office of Research Administration of New York Medical College.
 26. Both Alison Goveia and Susan Dudick remain employed in my department at New York Medical College. At the time the subject maintenance fees were due, and presently, both Ms. Goveia and Ms. Dudick enjoy a reputation as reliable, trustworthy and valuable staff members at New York Medical College.
 27. At the time the subject maintenance fees were payable, Alison Goveia was an Administrative Assistant in the Office of Research Administration at New York Medical College. Ms. Goveia received all mail addressed to the Office of Research Administration, then sorted the mail and distributed it to the appropriate recipients or my administrative assistant. Specifically, Ms. Goveia received all mail addressed to the Office of Research Administration and directed all mail that was addressed to me or Dr. Manne to my administrative assistant, Susan Dudick, for my review.
 28. At the time the subject maintenance fees were payable, Susan Dudick received all mail addressed to me and/or Dr. Manne. Ms. Dudick and I would then review the mail daily where I would decide the appropriate response for each piece of mail and direct Ms. Dudick accordingly, or I would handle the matter myself.
 29. To date, I still occasionally receive mail that is addressed to Dr. Manne and respond to it appropriately.
 30. At the time the subject maintenance fees were payable, I was responsible for receiving notices of maintenance fees due and approving payment of the maintenance fees for the subject patent.
 31. Based on our recent investigation, CPA stated they attempted to notice New York Medical College, via United States Postal Service, that the subject maintenance fees were due; thus, it appears that CPA's docketing system for notifying New York Medical College of the subject maintenance fees was functioning properly. (See Attachment 4).

32. However, I did not receive notice from CPA that the subject maintenance fees were due.
33. I also did not receive notice from Graham & James that the subject maintenance fees were due.
34. I have attempted to identify and locate the individual that may have been responsible for the error that resulted in the failure to pay the subject maintenance fees. To date, I have been unsuccessful in these efforts.
35. On December 17, 2009, I was notified, via an e-mail message from New York Medical College general counsel— Waldemar A. Comas, Esq.—that the subject patent had expired due to failure to pay maintenance fees. (*See Attachment 5.*)
36. I immediately began an investigation into the circumstances surrounding the failure to pay the subject maintenance fees. At the time, I believed that locating the physical, law firm patent prosecution file would be helpful in resolving both the immediate problem of the unpaid maintenance fees as well as preventing future non-payment of maintenance fees for the subject patent.
37. The law firm of Amster, Rothstein is handling many of the New York Medical College's patents which have been licensed to Phoenix Flow Systems. Therefore, on December 30, 2009, I contacted Dr. Alan Miller of Amster, Rothstein in an effort to obtain additional information about the location of the physical, law firm prosecution file. (*See Attachment 6.*)
38. Dr. Miller informed me that that it would be best to contact Skadden, Arps to try to locate the physical file of the case.
39. On or about December 30, 2009, I contacted Skadden, Arps regarding the subject patent and was informed that they transferred handling of the file to Stefan Kirchanski of Graham and James, L.L.P. in 1998.
40. On December 31, 2009, I contacted New York Medical College General Counsel—Mr. Comas—for assistance with locating Mr. Kirchanski and/or Graham and James, L.L.P.. (*See Attachment 7, bottom e-mail message.*)
41. On February 12, 2010 and March 18, 2010, I reminded Mr. Comas that I was waiting for contact information for Mr. Kirchanski and/or Graham & James. (*See Attachment 7, first and second e-mail messages.*)

42. On May 5, 2010, I, again, contacted Skadden, Arps in an attempt to obtain additional information on the location of the prosecution file. However, this request did not yield helpful information.
43. On or about May 6, 2010, I contacted the licensee of the subject patent, Phoenix Flow Systems, in an attempt to locate contact information for Stefan Kirchanski. Margie Becker, of Phoenix Flow Systems, provided me with Mr. Kirchanski's contact information.
44. During my investigation, I also discovered that the law firm Graham & James—the firm that I believe should have possession of the physical file—dissolved and split out of existence in July, 2000.
45. On or about May 7, 2010, I called Stefan J. Kirchanski, now at Venable, L.L.P. to locate the physical prosecution file.
46. On May 12, 2010, after unsuccessfully attempting to locate the physical file or get further answers on my own as to how the subject maintenance fees went unpaid, I requested that NADA JAIN, P.C. investigate the matter and attempt to reinstate the subject patent.
47. I have since worked with their attorneys and staff to gather information and evidence pertinent to the circumstances surrounding the failure to pay the maintenance fees in the above-identified patent.
48. I make every effort to remain vigilant in maintaining all of New York Medical College's intellectual property rights. I have instituted, managed and maintained business routines to ensure protection and prosecution of patents and continue to remain active in managing New York Medical College's intellectual property rights.
49. I declare that the above statements are true to the best of my knowledge.

Date:

8/31/10

Signed:

Catharine Crea

Catharine Crea

ATTACHMENT 1



NEW YORK MEDICAL COLLEGE

OFFICE OF RESEARCH ADMINISTRATION
VALHALLA, NEW YORK 10595 TEL 914-594-4480 FAX 914-594-4694

July 10, 2002

Computer Patent Annuities
Suite 400
225 Reinekers Lane
Alexandria, VA 22314

Account #: 7486079

Dear Sir/Madam:

Please find the answered renewal notice attached. Your attention to this matter is appreciated.

Sincerely,

A handwritten signature in cursive script that reads "Stella Manne".

Stella Manne, Ph.D.
Director, Technology Development
Industry Sponsored Research

SM/jc
Encl.

Computer Patent Annuities Limited Partnership

PO Box 778
Jersey JE1 1BL
Channel Islands

Phone: +44 (0) 1534 888711
Fax: +44 (0) 1534 888747
E-mail: cpa@cpajersey.com
Web Site: www.cpaJersey.com



REMINDER / RENEWAL NOTICE

The following cases are due for renewal: please return the tear-off strip promptly, marked with your instructions. The estimated costs shown do not include any late fines for renewal after the due date. Payment should be sent with instructions unless other arrangements have been agreed: please contact us if you wish to take advantage of our Automatic payment system as this method can save costs.

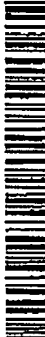
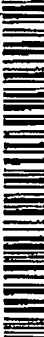
New York Medical College
Attn: Dr Stella Manne
Office Of Research
Administration Building Room 202
Grasslands Avenue
Valhalla, New York 10595

PLEASE RETURN TO:

Computer Patent Annuities Inc
Suite 400
225 Reinekers Lane
Alexandria, VA 22314
U.S.A.

TEL: {703} 739-2234
FAX: {703} 739-2815

Please make cheques payable to:
Computer Patent Annuities, Jersey

Account No.	US Dollar	Date	Page	7486079	US Dollar	1	01 JUL 2002	NEW YORK
7486079		01 JUL 2002	1					1
Country Type No.	Due Date Case Expiry	Annuity	Your Reference Proprietor	Cost	YES/NO	Please indicate whether you wish us to pay (indicate YES) or Remove (indicate NO) against each case, in the column provided.		
U.S.A. Small Entity 5912126	15 DEC 2002 28 AUG 2016	1	NYMC 1076US ZBIGNIEW DARZYNKIEWICZ ET AL	US\$550.00	yes	 US WS 5912126 1 15 DEC 2002 US\$550.00		
U.S.A. Small Entity 5898035	27 OCT 2002 28 AUG 2016	1	NYMC 1076US NEW YORK MEDICAL COLLEGE	US\$550.00	yes	 US WS 5898035 1 27 OCT 2002 US\$550.00		
Grand-total:				US\$1100.00	Grand-total: US\$1100.00			

RECEIVED
JUL 10 02

OFFICE OF REVENUE ADMINISTRATION

Registered as a Limited Partnership under the Limited Partnerships (Jersey) Law, 1994, Registered Office: CPA House, 11-15 Canton Place, St. Helier, Jersey

PATENT DESIGN & TRADE MARK RENEWALS & SOFTWARE SOLUTIONS
WORLDWIDE TRADE MARK SEARCHING & WATCHING

Authorised by: *John Manno*
Date: *July 1, 2002*

ATTACHMENT 2

TYPE OR PRINT IN UPPER CASE LETTERS

NEW YORK MEDICAL COLLEGE - CHECK REQUEST NO. 274434TO: ACCOUNTS PAYABLE — DATE: November 11, 1999FROM: Janet M Powers DEPT: Office of Research Administration

PAYEE AND ADDRESS:

Graham & James LLP801 South Figueroa Street 14th Flr.Los Angeles, CA 90017-5554Please issue a check in the
amount of \$ 2,052.17

no later than _____

Drawn to the order of payee and charge to Account(s)
indicated below.

PURCHASE ORDER NUMBER	INVOICE NUMBER	INVOICE DATE	ACCOUNT(s) NO.	AMOUNT
	341423	2/15/99	01-86-02-601	\$ 134.85
	361029	7/15/99	01-86-02-601	\$ 1,377.00
	368436	9/20/99	01-86-02-601	540.32

Mail Direct to Payee ☒ Send Attached Forms ☐ Send Direct to Me _____

ROOM NO/BUILDING

EXPLANATION: Legal services for "Methods for Labeling DNA Ends with Halogenated
Nucleotides and Detecting Same with Antibodies" by Zbigniew Darzynkiewicz

Payee Social Security No. _____

Approved: _____

Requested By: _____

Date: _____

*Please attach originals of invoices or other supporting
documentation. (See instructions)**State reason for nondelivery direct to payee
in the above explanation section.

ORIGINAL

ATTACHMENT 3

TO: ACCOUNTS PAYABLE — DATE: February 9, 2001

FROM: Catharine Crea DEPT: Research Administration

PAYEE AND ADDRESS:

Withers & Rogers

Acct #630-9046739

The Bank of New York

P.O. Box 19546

Newark, NJ 07195-0546

Please issue a check in the
amount of \$ 448.12

no later than

Drawn to the order of payee and charge to /
indicated below.

PURCHASE ORDER NUMBER	INVOICE NUMBER	INVOICE DATE	ACCOUNT(s) NO.	AMOUNT
			01-86902 601.01	448.12

☒ Mail Direct to Payee ☐ Send Attached Forms ☐ Send Direct to Me

ROOM NO/BUILDING

EXPLANATION: annuity & surcharge due Feb. 28 for Patent #PCT/US 96/14250

"Methods for labeling DNA ends with halogenated nucleotides and detect
with antibodies"

Payee Social Security No. _____ Approved: Catharine Crea

Requested By: Catharine Crea Date: 2/12/01

*Please attach originals of invoices or other supporting
documentation. (See instructions)**State reason for nondelivery direct to payee
in the above explanation section.

ORIGINATOR'S

ATTACHMENT 4

From: trademarks@cpaglobal.com on behalf of patents@cpaglobal.com
To: bshade@nadajain.com
Subject: Re: TMS2922195 - Attn: Rachel, U.S. Patent No. 5,912,126 Authorization
Date: Tuesday, July 13, 2010 10:26:52 AM

Dear Brian Shade,

Please accept this e-mail as written confirmation of the following patent case history details.

RE: US Patent No. 5912126

Please be advised that the above patent lapsed off of CPA's files 16 JUN 2007 from New York Medical College's account no. 7486079. All documents were mailed to:

New York Medical College
Attn: Dr Stella Manne
Administration Building Room 202
Grasslands Avenue
Valhalla, NY 10595
USA

The renewal history is as follows:

1st Reminder for the first (3.5yr) annuity was mailed : 01 JUL 2002
Pay Instructions were received : 16 JUL 2002
Agent Instructed (Paid): 27 AUG 2002
Official Receipt stored : 07 OCT 2002

1st Reminder for the second (7.5yr) annuity was mailed : 30 JUN 2006
2nd Reminder was mailed : 01 SEP 2006
3rd Reminder was mailed : 29 DEC 2006
4th and Final Reminder was mailed : 01 MAY 2007
Case Lapsed off of CPA's Files : 16 JUN 2007

Kind Regards,

Rachel D Cowan

CPA NA CSC
CPA Global

Tel: 1 703 739 2234
Fax: 1 703 739 2815
Toll Free: 1 866 739 2239

CPA Global is a leading provider of legal support services and the world's top intellectual property management specialist.
For further information about our products and services go to www.cpaglobal.com

From: bshade@nadajain.com
Date: 14/06/2010 20:16:58

Subject: Attn: Rachel, U.S. Patent No. 5,912,126 Authorization

Rachel:

Attached, please find a copy of the requested authorization from New YorkMedicalCollegeto release information pertaining to the maintenance fee payments made on the above patent. You may recall, over the phone, I requested information regarding who issued the authorization that CPA received from New YorkMedicalCollegeon or about July 16, 2002 for the first maintenance fees that were paid. Additionally, if you could forward the copies of the notices CPA sent out in 2006 and 2007 and any address changes/previous addresses that you have on file, I would appreciate it. If you have any questions or need additional information, feel free to contact me via phone or e-mail.

Thank you,

Brian Shade

Law Clerk

Nada Jain, P.C.

560 White Plains Road

Tarrytown, NY10591

Phone: 914.333.0610 x152

Fax: 914.333.0615

LEGAL NOTICE

This message and any attachments are confidential and may be privileged or otherwise protected from disclosure. If you are not the intended recipient, please contact the sender and delete this message and any attachment from your system. If you are not the intended recipient, you must not read or copy this message or attachments or disclose the contents to any other person.

- US Pat No 5912126 Auth.pdf

ATTACHMENT 5

Crea, Catharine

From: Comas, Waldemar
Sent: Thursday, December 17, 2009 10:08 AM
To: Crea, Catharine
Subject: FW: Touro/NYMC
Attachments: 20091217081817_20091217_081827.pdf

Please help me with the requested information.

WAC

From: Scheller, Brad [mailto:BMScheller@mintz.com]
Sent: Thursday, December 17, 2009 8:40 AM
To: Comas, Waldemar
Cc: Lowe, Sarah
Subject: RE: Touro/NYMC

Hi Tony,

Further to our correspondence yesterday, the attached agreement with Phoenix Flow Systems relates to U.S. patent no. 5,912,126. According to the U.S. Patent & Trademark Office website, this patent recently expired due to failure to pay maintenance fees. Could you please look into this, namely let us know if Phoenix knows about this and what the current status of the license is?

Thanks,
Brad

5/11/2010

ATTACHMENT 6

Crea, Catharine

From: Alan Miller [amiller@ARELAW.com]
Sent: Wednesday, December 30, 2009 10:45 AM
To: Crea, Catharine
Cc: Craig Arnold
Subject: RE: Maintenance fee payment due January 9, 2010, U.S. Patent No.: 6,417,343 B1, our file 63653/22

Dear Catharine,

Thank you for your e-mail. We will plan to pay the maintenance fee.

In regard to U.S. Patent No. 5,912,126, I see from the Patent Office website that the attorney of record is:
ROBERT S MACWRIGHT
SKADDEN ARPS SLATE MEAGHER & FLOM
919 THIRD AVENUE
NEW YORK, NY
10022

According to the Patent Office website. U.S. Patent No. 5,912,126 expired on June 15, 2007 for failure to pay the maintenance fee. I suggest that you ask Robert MacWright for clarification.

Best regards,

Alan Miller

From: Crea, Catharine [mailto:CATHARINE_CREA@NYMC.EDU]
Sent: Wednesday, December 30, 2009 9:16 AM
To: Alan Miller
Subject: RE: Maintenance fee payment due January 9, 2010, U.S. Patent No.: 6,417,343 B1, our file 63653/22

Please pay the fee. A check for \$2,880 will be sent shortly. Staff is out until after the new year.

On another matter, according to the U.S. Patent & Trademark Office, U.S. patent no. 5,912,126 has expired due to failure to pay maintenance fees. Can you shed any light?

Thank you and Happy New Year.

Catharine Crea
Associate Dean for Research Administration
New York Medical College
Valhalla, NY 10595
phone: 914 594-4480
fax: 914 594-4694
email: crea@nymc.edu

From: Alan Miller [mailto:amiller@ARELAW.com]
Sent: Tuesday, December 29, 2009 5:26 PM
To: Crea, Catharine
Subject: Maintenance fee payment due January 9, 2010, U.S. Patent No.: 6,417,343 B1, our file 63653/22

5/20/2010

Re: U.S. Patent No.: 6,417,343 B1

Title: PHYSICAL SEPARATION OF NUCLEIC ACIDS
BY ANTIBODIES TO HALOGENATED NUCLEOTIDES

inventors: Darzynkiewicz, Traganos & Juan

ur File: 63653/22

Dear Catharine:

Further to my October 29, 2009 letter, as a Reminder, the next maintenance fee payment for the above-identified patent is due January 9, 2010. The Patent Office fees for a non-small (large) entity are \$2,480.00. Please advise us if large entity status is no longer appropriate. If you would like us to pay the maintenance fee, please send us a check for \$2,880.00 to cover the Patent Office fees and our service fee. Please contact me if you have any questions.

Very truly yours,

Alan D. Miller, Ph.D., Esq.
AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, New York 10016
Main Tel: 212 336 8000
www.arelaw.com

Direct: 212 336 8094
Fax: 212 336 8001
E-mail: amiller@arelaw.com

This e-mail transmission and any attachments are intended only for the party to whom

This e-mail transmission and any attachments are intended only for the party to whom

5/20/2010

ATTACHMENT 7

Crea, Catharine

From: Crea, Catharine
Sent: Thursday, March 18, 2010 4:40 PM
To: Comas, Waldemar
Cc: Dudick, Susan; Longo, Karen
Subject: FW: U.S. Patent No. 5,912,126

Tracking: **Recipient** **Read**
 Comas, Waldemar
 Dudick, Susan Read: 3/18/2010 4:46 PM
 Longo, Karen

Still waiting to hear from you about Stephan J. Kirchanski of Graham & James, which, at the time was in Costa Mesa, California. You were going to check or have Kelley Drye check.

From: Crea, Catharine
Sent: Friday, February 12, 2010 12:08 PM
To: Comas, Waldemar
Subject: FW: U.S. Patent No. 5,912,126

This is the one outstanding request and I have a new one question regarding a new speech language clinical practice. Talk to you soon.

Catharine

From: Crea, Catharine
Sent: Thursday, December 31, 2009 11:38 AM
To: Comas, Waldemar
Subject: U.S. Patent No. 5,912,126

Tony,

The saga of determining the status of the referenced patent went from Amster, Rothstein (which apparently never had the case) to Skadden Arps. Skadden tells me Stella Manne, on 10/22/98, transferred the file to one Stephan J. Kirchanski of Graham & James, which, at the time was in Costa Mesa, California. Can you please help me find these people so I can find out what happened and when?

Catharine

3/23/2010



Docket No. 1080/0011US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 5,912,126 (Formerly U.S. Appl. Ser. No.: 08/727,509)

Filed: 10/22/1996

Issued: 6/15/1999

For: **Methods for Labeling DNA Ends with Halogenated Nucleotides and Detecting Same with Antibodies**

DECLARATION BY ALISON GOVEIA

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

USPTC
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2019 OCT 18 PM 3:59

1. My name is Alison Goveia. I am an administrative assistant in the Office of Research Administration at New York Medical College, Valhalla, New York, 10595 and am responsible for, among other things, receiving and distributing mail received in the Administrative Building at New York Medical College. I write this declaration in support of the petition to accept an unavoidably delayed payment of a maintenance fee for the above-captioned patent.
2. I am an employee of New York Medical College and receive no special benefits from the execution of this declaration.
3. At the time the subject maintenance fees were payable, in the period 2006/2007, I was employed as an administrative assistant in the Office of Research Administration at New York Medical College and my duties included receiving and distributing all mail for the staff in the Office of Research Administration.
4. Daily, I received the mail addressed to the Office of Research Administration staff and directed it to the appropriate individuals for their review. I did not make decisions regarding which mail to deliver to staff and I did not discard mail that was addressed to staff.

5. I was employed at New York Medical College as an administrative assistant in the Office of Research Administration at the time that Dr. Stella Manne's position was eliminated in 2005 and I knew that all mail addressed to Dr. Manne was to be redirected to Associate Dean Catharine Crea.
6. At the time the subject maintenance fees were payable, I do not recall receiving mail from Computer Patent Annuities addressed to Dr. Manne. However, if it were received, I would have redirected it to Dean Crea's administrative assistant, Susan Dudick. I redirected, and continue to redirect, all mail addressed to Dr. Manne to Ms. Dudick.
7. To date, I still occasionally receive and redirect mail addressed to Dr. Manne and I redirect it to Ms. Dudick for Dean Crea's review.
8. I declare that the above statements are true to the best of my knowledge.

Date: 8/31/10

Signed: Alison Goveia
Alison Goveia